Without addressing the merits of the Office Action rejection, applicants respectfully request withdrawal of the rejection based on applicants' declarations submitted herewith under 37 C.F.R. § 1.131, establishing the applicants' invention was conceived and actually reduced to practice prior to the earliest filing date that can be accorded to either Chern or Bossemeyer.

Before undertaking a substantive review of the facts contained in the declarations, applicants set forth brief statements of the law pertinent to a declaration swearing behind a reference. Section 715.02 of the M.P.E.P. states that a affidavit or declaration under 37 C.F.R. § 1.131 must establish possession of either the whole invention claimed or something falling within the claim, in the sense that the claim as a whole reads on it. Furthermore, applicant may overcome a 35 U.S.C. § 103(a) rejection based on a combination of references by showing completion of the invention by the applicant prior to the effective date of any of the references. (M.P.E.P. § 715.02).

37 C.F.R. § 1.131 states that the priority of an invention may be shown by any satisfactory evidence of the fact. In general, proof of actual reduction of practice requires a showing that the apparatus actually existed and worked for its intended purpose. (M.P.E.P. § 715.07). The term "reduction to practice" has the same definition under 37 C.F.R. § 1.131 as the term is used in an interference proceeding. "In an interference proceeding, a party seeking to establish an actual reduction of practice must satisfy a two-prong test: (1) the party constructed an embodiment or performed a process that met every element of the interference count, and (2) of the embodiment or process operated for its intended purpose. *Eaton v. Evans*, Fed. Cir., No. 97-1267, as cited in M.P.E.P. § 2138.05. For an actual reduction of practice, the invention must have

been sufficiently tested to demonstrate that it will work for its intended purpose, but need not be in a commercially satisfactory state of development.

Claims 1-4, 7, 9-10, 12-18, 21, 23-24 and 26-28

Having set forth the appropriate framework for an analysis of whether reduction of practice occurred prior to the critical date of Chern, applicants submit that upon consideration of the facts spelled out in the attached declarations and supported by the evidentiary documents (Exhibits A and B), the burden to show actual reduction of practice before the critical date of Chern has been met and respectfully requests withdrawal of the rejection under 35 U.S.C. § 102(e) for the following reasons. The Claims 1-4, 7, 9-10, 12-18, 21, 23-24 and 26-28 have been rejected under 35 U.S.C. § 102(e) as being unpatentable over Chern. The earliest effective date of Chern is September 20, 1999, however, an argument may be made that August 27, 1999 is the earliest date if the earlier application of Chern contains the same subject matter, however such is not asserted in the Office Action. Claims 1-4, 7, 9-10, 12-18, 21, 23-24 and 26-28 read on a method and apparatus for method of providing a response to a request from a wireless device. As described in more detail below, the attached 37 C.F.R. § 1.131 declarations ("attached declarations"), which are supported by evidentiary materials, establish that subject matter falling within the scope of Claims 1-4, 7, 9-10, 12-18, 21, 23-24 and 26-28 was actually reduced to practice on or before August 27, 1999 (the earliest possible date for Chern).

Paragraph 2 of the attached declarations establishes that the method defining Claims 1-4, 7, 9-10, 12-14 was reduced to practice prior to August 27, 1999. More

specifically, a prototype of a software program was produced prior to August 27, 1999. The program included providing a response to a request from a wireless device.

Claims 15-18, 21, 23-24 and 26-28 are computer apparatus claims, having language that parallels the language of respective Claims 1-4, 7, 9-10, 12-14. Accordingly, these claims are allowable for the same reasons as their respective methods claims.

Exhibit A and B, attached to the attached declarations, establishes that source code for a working prototype of the claimed invention was written as early as May 14, 1999.

As discussed above, the attached declarations establish that the invention claimed in this application was actually reduced to practice before August 27, 1999, the earliest filing date that can be accorded to the Chern patent, thereby removing this patent as a reference.

Claims 5-6, 8, 11, 19-20, 22 and 25

Having removed Chern as a reference, it is clear that Claims 5-6, 8, 11, 19-20, 22 and 25 are allowable as well as Chern is the primary reference used to reject Claims 5-6, 8, 11, 19-20, 22 and 25. As noted above, Section 715.02 of the M.P.E.P. states that a rejection under 35 U.S.C. § 103(a) based on a combination of references, may be overcome by showing completion of the invention by the applicant prior to the effective date of any of the references. Therefore, Claims 5-6, 8, 11, 19-20, 22 and 25 are allowable as well.

CONCLUSION

Based on the attached declarations and evidence provided therein, applicants submit that Chern is no longer a viable reference, whereby all of the pending claims are now in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 689-1216. If any fees are due in connection with filing this paper, the Commissioner is authorized to charge Deposit Account No. 500393.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT

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